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09/714,018	11/16/2000	Harry Thomas Kloor	18822-11	5553

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,018

Applicant(s)

KLOOR, HARRY THOMAS

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 and 59-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The "Amendment and Response" filed on August 31, 2006 has been considered.

Applicant's remarks pertaining to the rejection under 35 USC § 112, first paragraph has overcome the Examiner's rejection.

Claims 1, 18, and 59 are amended. Claims 1-57 and 59-62 remain pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-14, 16, 18, 20-27, 29-31, 33, 56, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,529,725 to Joao et al. in view of U.S. Patent No. 6,473,740 to Cockrill et al.

Regarding **claim 1**, Joao discloses a method for authorizing a transaction comprising: sending, receiving, and storing contact information (database(s) 3H; see col. 16, lines 4-13; col. 6, lines 15-21; col. 31, lines 49-62); initiating into a credit card transaction (col. 5, lines 24-29); sending the authorization request to the user from an authorization agent (col. 6, lines 15-47), wherein the authorization agent is a bank that issued the credit card to the user, a credit card company, or an agent of the bank or the credit card company (col. 13, lines 52-65); receiving the authorization request, wherein

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the authorization request is received by the user and sending a respond to the authorization request from the user (col. 6, lines 37-65); receiving the response, wherein the response is received by the authorization agent and completing the transaction (col. 7, lines 18-40); **[claims 2-5, 12-14]** over the Internet (col. 10, lines 3-10); using email (col. 10, lines 46-49); a telephone line (col. 4, line 66 – col. 5, line 1; col. 5, lines 16-17), or wireless system (col. 5, lines 16-18), or a personal communication device (col. 67 – col. 5, line 6), or a cellular telephone (col. 29, lines 10-25; col. 32, lines 20-29) or pda (col. 38, lines 5); **[claims 6-7]** initiating the transaction includes transmitting a credit card number to a payee of the transaction (col. 5, lines 31-43) at an online store (col. 13, lines 7-20); **[claims 8-10]** a soft-card software for authorization (col. 7, lines 45-67; col. 16, lines 4-31); and **[claim 16]** information is entered into a website (col. 10, lines 3-6).

Joao does not explicitly disclose the personal data of the user that verifies the user's identity. Joao disclose the apparatus is designed or programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67). Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12).

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Moreover, Joao discloses the account owner may program the apparatus for proof of identity of which the types of proof may be specified (col. 42, lines 41-42).

Cockrill, on the other hand, teaches the personal data of the user that verifies the user's identity (col. 11, lines 36-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include the personal data of the user that verifies the user's identify, in order to validate whether the personal information collected matches the credit card number (Cockrill, col. 11, lines 45-47).

Regarding **claim 18**, Joao discloses a method for allowing an owner to approve a transaction comprising: acquiring contact information (database(s) 3H; see col. 16, lines 4-13; col. 6, lines 15-21; col. 31, lines 49-62); receiving a request to authorize (col. 6, lines 37-65), wherein the authorization agent is a bank, a credit card company, or an agent of the bank or the credit card company (col. 13, lines 52-65); using the contact information to the send the request (col. 6, lines 37-65, col. 7, lines 18-40; col. 31, lines 49-62); and sending approval (col. 6, lines 37-65, col. 7, lines 18-40); [**claims 20-27, 30-31, 33**] as set forth above for claims dependent from claim; and [**claim 29**] monitoring the owner and using the latest information to send the request to the owner (col. 10, lines 31-41).

Joao does not explicitly disclose receiving a request to authorize a transaction, subsequent to acquiring the contact information. Joao disclose the apparatus is designed or programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone

number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67).

Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12).

Cockrill, on the other hand, teaches the receiving a request to authorize a transaction, subsequent to acquiring the contact information (col. 10, line 66 – col. 11, line 12; col. 11, lines 13-60; Figure 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include the receiving a request to authorize a transaction, subsequent to acquiring the contact information, in order to validate the credit card number by matching the information collected from the customer to the credit card number (Cockrill, col. 11, lines 45-47).

Regarding **claim 56**, Joao discloses a method for parties to communication a transaction as set forth above in detail for claim 1.

Regarding **claim 59**, Joao discloses a system for authorization a transaction, comprising a server (col. 13, lines 66 – col. 14, line 3); a card registered with the server (col. 13, lines 51-65); and **[claims 60-62]** a credit card transaction over the Internet (col. 5, lines 24-29; col. 10, lines 3-10).

Joao does not explicitly disclose a communication channel, subsequent to the card being registered with the server. Joao disclose the apparatus is designed or

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programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67).

Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12).

Cockrill, on the other hand, teaches a communication channel, subsequent to the card being registered with the server (col. 10, line 66 – col. 11, line 12; col. 11, lines 13-60; Figure 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include a communication channel, subsequent to the card being registered with the server, in order to validate the credit card number by matching the information collected from the customer to the credit card number (Cockrill, col. 11, lines 45-47).

Claims 11, 17, 28, 36, 37, 39, and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,529,725 to Joao et al. in view of U.S. Patent No. 6,055,505 to Elston.

Joao substantially discloses the claimed invention, however, it does not disclose requiring a password/PIN.

Elston discloses a password/PIN (col. 3, line 49 – col. 4, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Joao, to include a password/PIN, as taught by Elston, because passwords/PINS provided added security to protect confidential information.

Claims 15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 5,760,771 to Blonder et al.

Joao substantially discloses the claimed invention, however, it does not disclose the use of an e-signature for an agreement.

Blonder teaches the use of e-signatures (see column 9, lines 24-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with e-signatures as taught by Blonder, because e-signatures add an additional level of security from fraud.

Claims 19 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 6,330,550 to Brisebois et al.

Joao substantially discloses the claimed invention, however, Joao does not disclose IP address.

Brisebois teaches the IP address (col. 4, lines 55-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with the IP address, as taught by Brisebois, because the IP address provided security to protect confidential information.

Claim 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view U.S. Patent No. 6,330,672 to Shur.

Joao substantially discloses the claimed invention, however, it does not disclose the use of a digital watermark.

Shur teaches the use of digital watermarks (see column 2, lines 20-30 and column 4, lines 56-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with digital watermarks as taught by Shur, because digital watermarks add an additional level of security from fraud.

Claims 35, 42-46, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 6,442,526 to Vance et al.

Joao substantially discloses the claimed invention, however, it does not disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Elston as applied to claim 36 above, and further in view of Official Notice.

Joao and Elston substantially disclose the claimed invention, however, the combination does not disclose that contact information is only established for a predetermined amount of time.

The Examiner takes Official Notice that is old and well known in the art to change PINs or passwords after a predetermined period of time.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with changing PINs/passwords, because modifying PINs provides an additional level of security from fraud.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Elston and Vance.

Joao and Elston substantially disclose the claimed invention, however, the combination does not disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Vance as applied to claim 42 above, and further in view of Official Notice.

Joao and Vance substantially disclose the claimed invention, however, the combination does not disclose an electronic wallet.

The Examiner takes Official Notice that using an electronic wallet for online purchases is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with an electronic wallet as is well known in the art, because electronic wallets store important personal and account information in a secure and easy to use format.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Vance as applied to claim 42 above, and further in view of U.S. Patent No. 6,390,362 to Martin.

Joao and Vance substantially disclose the claimed invention, however, the combination does not disclose a check with a bar code.

Martin teaches the use of a check with a barcode (see column 4, lines 5-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with check payment with a barcode as taught by Martin, because utilizing a check with a barcode adds an additional level of security to reduce fraud.

Response to Arguments

Applicant's arguments with respect to claims 1, 18 and 59 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed August 31, 2006 have been fully considered but they are not persuasive.

Applicant remark that "Joao reference fails to disclose a single authorization agent that acquires contact information for multiple parties for purposes of authenticating a single transaction, or sending an authorization request to those multiple parties and requiring approval from all of the parties before approving a single transaction".

The Examiner notes that Joao does disclose "a single authorization agent that acquires contact information for multiple parties for purposes of authenticating a single transaction, or sending an authorization request to those multiple parties and requiring approval from all of the parties before approving a single transaction". Joao discloses a central processing computer may service any predefined group of card holders (col. 4, lines 27-28). Joao discloses the cardholder may program the apparatus so as to limit the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, limits on the dollar amounts of transaction pertaining to each authorized vendor and service provider; daily spending limits, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized; and/or any other limitations and restrictions regarding amount of transaction and parties involved. (Col. 42, lines 4-18). These claims were given the broadest reasonable interpretation in an effort to reduce the possibility that these claims, once issued, will be interpreted more broadly than is justified. See *In re Prater*, 415 F.2d 1393, 1404-05,

162 USPQ 541, 550-551 (CCPA 1969).

Such central processing computer servicing any predefined group of card holders; and cardholder may program the apparatus so as to limit the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card and/ or any other limitations and restrictions regarding parties involved are considered "a single authorization agent that acquires contact information for multiple parties for purposes of authenticating a single transaction, or sending an authorization request to those multiple parties and requiring approval from all of the parties before approving a single transaction".

Applicant remarks that "neither Joao, Elston, nor the combination thereof, teach or suggest anywhere monitoring Internet addresses, comparing Internet addresses, and approving a transaction request based on the comparison of Internet addresses".

The Examiner notes that Joao, Elston and the combination thereof, teach or suggest monitoring Internet addresses, comparing Internet addresses, and approving a transaction request based on the comparison of Internet addresses. Joao does disclose a point-of sale terminal is utilized at locations of the seller and service provider such as at a retail store, and the terminal may be located at the site of the goods or service provider or vendor, such as in cases when the sale is an Internet transaction (col. 4, lines 15-22). Joao also discloses the cardholder may program the central processing computer and the server computer (col. 41, lines 66-67). The cardholder may program the apparatus so as to limit the types of transaction involving, goods and

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services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized; and/ or any other limitations and restrictions regarding amount of transaction and parties involved. (Col. 42, lines 4-18) Joao discloses the cardholder account owner may utilize the apparatus to its fullest capability over the Internet and World Wide Web (col. 37, lines 26-29). The cardholder owner may utilize the apparatus to monitor the operation of the apparatus over the Internet from any suitable computer or device and from any location (col. 37, lines 30-37). These claims were given the broadest reasonable interpretation in an effort to reduce the possibility that these claims, once issued, will be interpreted more broadly than is justified. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Such point-of sale terminal providing an Internet sales transaction; the cardholder limiting the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized and/ or any other limitations and restrictions regarding amount of transaction and parties involved; and the cardholder owner may utilize the apparatus to monitor the operation of the apparatus over the Internet from any suitable computer or device and from any location are considered "monitoring Internet addresses, comparing Internet addresses, and approving a transaction request based on the comparison of Internet addresses".

Applicant remarks that "the combination of the reference clearly fails to teach or suggest "providing a predetermined purchaser order information about a transaction through the Internet; and comparing the predetermined purchase order information and the actual purchaser order information to whether approve a request".

The Examiner notes that the combination of the reference does teach or suggest "providing a predetermined purchaser order information about a transaction through the Internet; and comparing the predetermined purchase order information and the actual purchaser order information to whether approve a request". Joao does disclose a point-of sale terminal is utilized at locations of the seller and service provider such as at a retail store, and the terminal may be located at the site of the goods or service provider or vendor, such as in cases when the sale is an Internet transaction (col. 4, lines 15-22). Joao also discloses the cardholder may program the central processing computer and the server computer (col. 41, lines 66-67). The cardholder may program the apparatus so as to limit the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, limits on the dollar amounts of transaction pertaining to each authorized vendor and service provider; daily spending limits, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized; and/ or any other limitations and restrictions regarding amount of transaction and parties involved. (Col. 42, lines 4-18) Joao discloses the cardholder account owner may utilize the apparatus to its fullest capability over the Internet and World Wide Web (col. 37, lines 26-29).

Such terminal providing Internet sales transaction; and cardholder may program the apparatus so as to limit the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, limits on the dollar amounts of transaction pertaining to each authorized vendor and service provider; daily spending limits, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized; and/ or any other limitations and restrictions regarding amount of transaction and parties involved are considered "providing a predetermined purchaser order information about a transaction through the Internet; and comparing the predetermined purchase order information and the actual purchaser order information to whether approve a request".

Applicant remarks that "there is no suggestion or motivation to combine these references to achieve the present claimed invention, nor would the combination of these references teach or suggest each and every claimed limitation". Applicant further remarks that "there would be no motivation to combine the non-card pre-transaction system of Vance with the real-time credit card system of Joao".

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Joao does not explicitly disclose the owner includes non-user of the card. However, Joao does disclose the cardholder may program the apparatus so as to limit the types of transaction involving, goods and services which may be purchased with the card and the stores and the service providers which may be authorized to accept the card, limits on the dollar amounts of transaction pertaining to each authorized vendor and service provider; daily spending limits, the service provider with which the card may be utilized, the geographical area or location within which the card may be utilized; and/ or any other limitations and restrictions regarding amount of transaction and parties involved (col. 42, lines 4-18). The Examiner then turns to Vance to further teach the owner includes non-users (employees) that are authorized by the owner. The motivation to combine is to preapprove purchases by employees allowing the organization to keep tighter control over spending.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
November 13, 2006

 11/13/06
MICHAEL CUFF
PRIMARY EXAMINER